



PATENT APPLICATION

HC TPA

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: Shuichi Tsukada
Serial No.: 10/806,209
Conf. No.: 1922
Filed: 3/24/2004
For: PNEUMATIC TIRE AND
MANUFACTURING METHOD
THEREOF
Art Unit: 1733
Examiner: Fischer, Justin R.

I hereby certify that this paper is being deposited with the United States Postal Service as FIRST-CLASS mail in an envelope addressed to: Mail Stop APPEAL BRIEF -PATENTS, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this date.

July 5, 2007

Date

Registration No. 29,367

Attorney for Applicant(s)

TRANSMITTAL

Mail Stop APPEAL BRIEF-PATENTS
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Transmitted herewith is a communication regarding the above-identified application.

- (X) Reply Brief (in triplicate).
- (X) The Commissioner is hereby authorized to charge any additional fees which may be required to this application under 37 C.F.R. 1.16-1.17, or credit any overpayment, to Deposit Account No. 07-2069. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 07-2069. A duplicate copy of this sheet is enclosed.
- (X) If a Petition under 37 C.F.R. 1.136(a) for an extension of time for response is required to make the attached papers timely and does not separately accompany this transmittal, Applicant hereby petition under 37 C.F.R. 1.136(a) for an extension of time for response in the above-identified application for the period required to make the attached response timely.

Respectfully submitted,
GREER, BURNS & CRAIN, LTD.

By

Patrick G. Burns
Registration No. 29,367

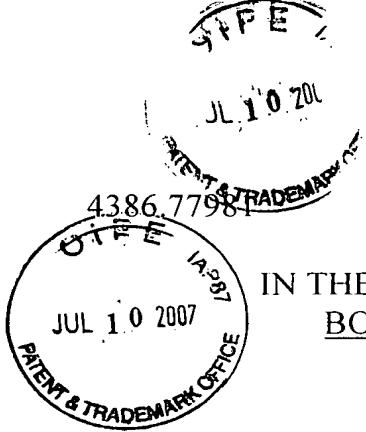
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July 5, 2007

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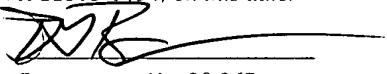


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Attorney for Applicant(s)

REPLY BRIEF

Mail Stop Appeal - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Examiner's Answer mailed May 11, 2007, please consider the following reply:

RESPONSE TO NEW GROUNDS FOR REJECTION

Claim 7 now stands rejected under § 103. As the examiner recognizes, claim 1 stands rejected over the same combination of references as claims 4 and 6, and the feature recited in claim 7 was previously considered in connection with claim 1. For these reasons, claim 7 stands or falls with independent claims 1 and 4.

ARGUMENT

In paragraph 10 of the Examiner’s Answer, the examiner argues that “the preponderance of evidence clearly suggests the general concept of forming tire component continuously or discontinuously.” The examiner also argues that “there would have been a reasonable expectation of success in forming the tire of Kajiwara or Numata with a discontinuous or intermittently arranged “volume adjusting member.” Finally, the examiner rejected applicants’ evidence of surprising results. In summary, the examiner cannot rely on general concepts of tire forming to establish a *prima facie* case of obviousness. Moreover, the examiner did not support the assertion that there would be a reasonable expectation of success, i.e., reducing road noise, by combining the cited references in the manner asserted, and the examiner’s wholesale rejection of the evidence of surprising results was in error. Each of these points will now be addressed.

The examiner’s reliance on general concepts of tire forming is simply insufficient. The examiner must “connect the dots” by showing how and why the cited references would be combined to derive the claimed invention. That has not been adequately done in this case.

The present invention produces reduced road noise. This result would not be apparent without testing, and there is no reason that other results might not have been obtained.

For example, forming tire components in a discontinuous manner might produce weakness in the tire, imbalance, loss of structural integrity, or uneven wear. The examiner did not provide evidence that any of these potential results would not be expected if the cited references were combined in the manner asserted. The examiner is using hindsight, and the results obtained by applicants to make this assumption.

The examiner disagrees with applicant's arguments regarding their showing of unexpected results. The examiner argues that the experiments did not use the closest prior art, but the closest prior art is a hypothetical device of unknown construction. For this reason, it is unreasonable for the examiner to expect such experimental results, and it is unreasonable for the examiner to completely reject applicant's evidence of unexpected results on this basis.

For the foregoing reasons, applicants submit that the examiner erred in rejecting the claims of this application, and respectfully request reversal, with instructions to allow this application.

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.

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